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JUL 26 2004

OFFICE OF PETITIONS

In re Application of :
Achilefu et al. :
Application No. 10/751,232 : DECISION REFUSING STATUS
Filed: January 2, 2004 : UNDER 37 CFR 1.47(a)
Attorney Docket No. MRD/57CP :
:

This is in response to the petition under 37 CFR 1.47(a), filed June 25, 2004 (certificate of mailing June 23, 2004).

The petition is dismissed.

Applicants are given TWO (2) MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a).

The above-identified application was filed on January 2, 2004, without an executed declaration. Accordingly, on April 23, 2004, the Office mailed a "Notice to File Missing Parts of Nonprovisional Application," requiring an executed declaration and a surcharge for the late filing of the declaration.

In response, on June 25, 2004 (certificate of mailing June 23, 2004), applicants filed the present petition, a declaration signed by 4 out of 6 joint inventors, and paid the necessary fees.

In the Declaration of Facts, Tammy Torres established that Mr.

Jimenez could not be located after diligent effort. Ms. Torres stated that she performed a web search to obtain his current address and telephone number. Mr. Jimenez's telephone number had been disconnected. Ms. Torres further explained that she sent a letter via Priority Mail to Mr. Jimenez's last known address, which was returned with no forwarding address. A copy of the internet search, the letter to Mr. Jimenez and the returned envelope accompany the petition. Applicants have complied with the requirements set forth in 37 CFR 1.47(a) as to Mr. Jimenez.

As to Dr. Achilefu, Ms. Torres stated that he indicated receipt of the Declaration and Assignment for Application No. 10/751,232 but was unwilling to review the documents without compensation.

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. Applicants lack item (1) as set forth above.

As to item (1), it appears that Dr. Achilefu was presented with only a copy of the Declaration and Assignment. Unless Dr. Achilefu was presented with a complete copy of the application papers, including the specification, claims and drawings, he could not attest that he has "reviewed and understands the application papers," and therefore, could not sign the declaration that he was given. Accordingly, applicants failed to show or provide proof that Dr. Achilefu, the nonsigning inventor, has refused to sign the declaration. See MPEP 409.03(d). To show that the inventor has refused to join in the application, applicants must show that a complete copy of the application papers, including the specification, claims and drawings, was presented to Dr. Achilefu, personally or through his designated representative, and that he did not respond to the request that he sign the declaration.

Applicants have not meet the requirement under 37 CFR 1.47(a) with respect to Dr. Achilefu.

Further correspondence with respect to this matter should be addressed as follows and **to the attention of Christina Tartera Donnell, Senior Petitions Attorney**:

By mail: Mail Stop Petition
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P.O. Box 1450
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By FAX: (703) 872-9306
Attn: Office of Petitions

By hand: U.S. Patent and Trademark Office
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Telephone inquiries concerning this matter may be directed to the
undersigned at (703) 306-5589.

Christina Tartera Donnell

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